UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,400	10/03/2003	Robert M. Congdon	LOT9-2003-0027-US1 (7321-	3520

46321 7590 06/14/2007 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487	**EXAMINER** EL CHANTI, HUSSEIN A

ART UNIT	PAPER NUMBER
2157	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/678,400	CONGDON ET AL.
	Examiner	**Art Unit**	
	Hussein A. El-chanti	2157	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>03 October 2003</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-14</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-14</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☐ All　b) ☐ Some * c) ☐ None of:

　　　　1. ☐ Certified copies of the priority documents have been received.

　　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/03</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive application filed Oct. 3, 2003. Claims 1-14 are pending

examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

2. Claims 1 – 14 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b)

A claim that requires one or more acts to be performed defines a process. However, not
all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460,
to be statutory, a claimed computer-related process must either: (A) result in a physical
transformation outside the computer for which a practical application in the technological arts is
either disclosed in the specification or would have been known to a skilled artisan, or (B) be
limited to a practical application within the technological arts.

3. Claims 1-14, in view of the above cited MPEP sections, are not statutory

because they merely recite a number of computing steps without producing any tangible

result and/or being limited to a practical application within the technological arts. The

"use of a computer" has not been indicated.

The disclosure of the application defines the "mail server cell" as a part of an

application and therefore the mail server cell is not a device but merely a software

application (see spec page 5, 2cd paragraph).

The disclosure of the application also defines the "application server" and "IMAP

server" as an application and not a device (see spec page 9, paragraph 1 and 2).

(2) "TANGIBLE RESULT"

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application."). "[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection." Diehr, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 ("It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . ."). In other words, the opposite meaning of "tangible" is "abstract."

4.   Claims 1 - 14, in view of the above cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by DeAnna et al., U.S. Patent No. 6,947,943 (referred to hereafter as Anna).

As to claim 1, Anna teaches a collaborative messaging system, a mail server cell comprising:

a logical grouping of application server nodes disposed within an application server (see col. 5 lines 46-60, col. 7 lines 7-35 and col. 3 lines 64-col. 4 lines 7, the Zeospehere server has a plurality of applications for communicating with a plurality of servers and devices);

an Internet Message Access Protocol (IMAP) compliant mail server coupled to said logical grouping of application server nodes (see col. 15 lines 5-15 and col. 16 lines 28-47, the Zeosphere server has an IMAP compliant application coupled to the plurality of other applications); and,

at least one data store configured for storing electronic mail messages processed in said IMAP compliant mail server (see col. 15 lines 43-54, the Zeosphere has a Mail receiver i.e. "data store" that stores messages).

As to claim 2, Anna teaches the mail server cell of claim 1, wherein said IMAP compliant mail server comprises a simple mail transfer protocol (SMTP) inbound request handler (mail receiver 173, fig. 4), an SMTP outbound request handler (mail sender 175, fig. 4), and a set of IMAP services (applications 171, 172 and mail

processor, fig. 4) coupled to said SMTP inbound and outbound request handlers (see fig. 4 and col. 16 lines 28-54).

As to claim 3, Anna teaches the mail server cell of claim 1, wherein said IMAP compliant mail server comprises a set of platform independent classes operable in a virtual machine environment (see col. 3 lines 50-60, Zeosphere server is implemented in a virtual machine environment).

As to claim 4, Anna teaches the mail server cell of claim 1, wherein said virtual machine environment is the Java virtual machine environment (see col. 4 lines 9-20 and col. 3 lines 50-60, the Zeosphere server is implemented in a JVM environment).

As to claim 5, Anna teaches the mail server cell of claim 4, wherein said IMAP compliant mail server comports with the J2EE specification (see col. 4 lines 9-20, J2EE implementation).

As to claim 6, Anna teaches the mail server cell of claim 1, further comprising a communicative coupling to authentication services provided through said application server (see col. 8 lines 4-9 and col. 5 lines 46-55).

As to claim 7, Anna teaches the mail server cell of claim 1, further comprising a communicative coupling to auto-provisioning services provided through the collaborative messaging system (see col. 7 lines 55-60, the Zeospehere is uses iMessenger to send and receive messages).

As to claim 8, Anna teaches the mail server cell of claim 1, further comprising a communicative coupling to a portal/portlet interface to said IMAP compliant mail server (see col. 16 lines 28-40).

As to claim 9, Anna teaches a collaborative messaging application comprising:

an Internet Message Access Protocol (IMAP) compliant mail server configured for operation within an n-tier enterprise environment provided by an application server (see col. 14 lines 31-45, col. 15 lines 5-15 and col. 16 lines 28-47, Zeosphere server is an IMAP compliant server that is based on a three-tier application);

a markup language driven interface to said IMAP compliant mail server disposed within a Web container in said application server (see col. 14 lines 5-65, the Zeosphere uses a GUI that is programmed using XML i.e. "markup language");

a data store configured to store messages process by said IMAP compliant mail server (see col. 15 lines 43-54, the Zeosphere has a Mail receiver i.e. "data store" that stores messages); and,

a directory configured to provide configuration and addressing data to said IMAP compliant mail server (see col. 15 lines 43-54 and col. 13 lines 50-col. 14 lines 30).

As to claim 10, Anna teaches the collaborative messaging application of claim 9, wherein said IMAP compliant mail server comprises a set of platform independent classes programmed for execution in a virtual machine and specifically operable in said

n-tier enterprise environment (see col. 4 lines 9-20 and col. 3 lines 50-60, the

Zeosphere server is implemented in a JVM environment).

As to claim 11, Anna teaches the collaborative messaging application of claim

10, wherein said virtual machine is a Java virtual machine and wherein said n-tier

enterprise environment is J2EE (see col. 4 lines 9-20 and col. 3 lines 50-60, the

Zeosphere server is implemented in a JVM environment using J2EE).

As to claim 12, Anna teaches the collaborative messaging application of claim 9,

further comprising an administrative console coupled to a messaging administrative

plug-in to said console facilitate management of said IMAP compliant mail server, said

markup language driven interface, said data store and said directory (see col. 4 lines

59-col. 5 lines 25 and col. 5 lines 61-col. 6 lines 24).

As to claim 13, Anna teaches the collaborative messaging application of claim 9,

further comprising authentication logic disposed within said application server and

communicatively linked to said IMAP compliant mail server for use by said IMAP

compliant mail server (see col. 8 lines 4-9 and col. 5 lines 46-55).

As to claim 14, Anna teaches the collaborative messaging application of claim 9,

further comprising auto-provisioning logic disposed within the collaborative messaging

application and communicatively linked to said IMAP compliant mail server for use by

said IMAP compliant mail server (see col. 16 lines 25-55).

6.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Hussein A. El-chanti whose telephone number is

(571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hussein Chanti